

REMARKS

United States Serial No. 10/523,845 was filed on July 29, 2005. The application is subject to a rejection of claims 1-18. In view of the amendments and remarks set forth herein, Applicant respectfully requests that the rejections of claims 1-18 be withdrawn and that a formal Notice of Allowance be issued with respect to claims 1-19.

35 U.S.C. § 103

Claims 1-2, 4-10 and 14-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 58-021489 to Matsumoto, et al. ("Matsumoto") in view of U.S. Patent No. 4,149,983 to Grier, et al. ("Grier") and U.S. Patent No. 4,461,712 to Jonnes ("Jonnes"). The present Office Action incorporates the First Office Action, dated September 15, 2008, by reference.

In the First Office Action, it is alleged that Matsumoto discloses that, based on the total weight of the solid lubricating composition, the range of possible concentrations of bicarbonate is from 25 to 98% by weight and the range of possible concentrations of surfactant is 1.5 to 28% by weight. Matsumoto, at page 4, lines 17-20, discloses "an aqueous dispersing liquid, containing hydrogen carbonate in the range from 5 to 55 wt%, a dispersing agent in the range from 0.1 to 1.0 wt%, a surfactant in the range from 1 to 2 wt%, and optionally metallic soap or graphite less than 12 wt%."

MPEP § 2143.01(V) states that, "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)". MPEP at 2100-140. There is no disclosure in Matsumoto that suggests that the solid components of the aqueous dispersing liquid ever exist as a mixture without water as a part of that mixture. Therefore, the dispersing liquid of Matsumoto that is used for hot and cold manufacturing processes of metal tubes (page 3, lines 1-3) as characterized in the Office Action, does not suggest a mixture of the non-aqueous components as a solid, as such a modification would render the disclosed dispersing liquid unsuitable for its intended purpose.

Combining Matsumoto with either or both of Grier and Jonnes does nothing to rectify the deficiency of Matsumoto described above. Grier discloses a composition for inhibiting the growth of microorganisms in metal working fluids comprising a 1,3,5-tris-(furfuryl)hexahydro-s-triazine, 40%-99.5% by weight of a carrier fluid, and 0.5%-30% by weight of a surfactant.

Jonnes discloses an aqueous gel lubricant that comprises a major proportion of water, an effective gelling amount of a polymeric polyelectrolyte acrylate compound having a molecular weight of at least about 1,000, an effective lubricating amount of a fatty acid salt compound, and an effective lubricating amount of polyalkylene oxide having a molecular weight of at least about 300,000. Jonnes relates to an aqueous gel lubricant useful in applications such as the installation of electrical or telephone cable in a conduit, which is a wholly distinct technical field from that of the other references or that of the present application.

Throughout Grier, the disclosure focuses on fluid metalworking aids. Likewise, Jonnes discloses a "substantially neutral aqueous lubricant" (Abstract, emphasis added). Nowhere in either reference is it suggested that the metalworking aids/lubricants can be anything other than fluid compositions. Thus, Matsumoto, combined with Grier and Jonnes, requires the use of liquid lubricants. Since the modification of Matsumoto renders the prior art combination unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification.

It is further alleged, in the present Office Action, that Matsumoto, Grier, and Jonnes disclose an aqueous composition containing the presently claimed components, that the water present in this aqueous composition clearly does not affect the basic and novel characteristics of the presently claimed composition, because the presently claimed composition is intended to be added to water and used as an aqueous lubricant, and that the presently claimed composition is not required to be a solid lubricating composition.

MPEP § 2111.03 states that "the transitional phrase 'consisting essentially of' limits the scope of a claim to the specified materials or steps 'and those that do not materially affect the basic and novel characteristic(s)' of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976)." Applicant respectfully submits that one of the novel

characteristics of the presently claimed lubricating composition is that it can be produced in solid form. As discussed above, none of Matsumoto, Grier, or Jonnes, or any combination thereof, suggests that the lubricating composition can be manufactured as a solid.

While the intention of the presently claimed solid lubricating composition is that it be added to water to form an aqueous solution before use, providing the composition to the job site as a solid overcomes many problems during manufacturing and transporting that would be encountered if the composition was manufactured as a liquid. Manufacturing the composition as a dry solid reduces the risks of spillage, erroneous dosing of the various components, and other problems associated with manufacturing a liquid composition. Transporting the composition in dry form to a job site also reduces risks that would be encountered during transportation of a liquid composition, and transporting the composition in dry form reduces the weight of the composition, thereby reducing the cost of transportation.

Therefore, claims 2, 7-10 and 14-18 cannot be suggested by the prior art as alleged by the Office. Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 2, 7-10 and 14-18.

With regard to claims 1 and 4-6, it is alleged in the present Office Action that Matsumoto teaches application of the lubricating composition to a metal tube. Applicant respectfully submits that the Office has mischaracterized Matsumoto. As discussed in the First Office Action and Applicant's Response B submitted on January 9, 2009, Matsumoto, Grier and Jonnes refer to aqueous lubricants useful in processes for manufacturing metal tubes and/or pipes in order to protect the tubes/pipes and tools used to manufacture them from being damaged during manufacture. This may be a fine distinction, but it is an important one. Matsumoto, Grier and Jonnes do not teach application of the lubricant to a metal tube. They teach application of the lubricant to a metal while it is being manufactured into a metal tube. Thus, there is no teaching or suggestion that the lubricant would be useful for any purpose related to the use of such metal tubes in transporting material, such as a cementitious composition. One of skill in the art would

not look to Matsumoto, Grier, Jonnes, or any combination thereof to solve the problem of lubricating cementitious composition conduits in order to allow the cementitious composition to flow more easily through the conduits.

Claim 1 has been amended to include the process step of pumping or dropping the cementitious composition through the conduit. Support for this amendment can be found at page 4, lines 1-2 of the present specification. None of the references, nor any combination thereof, discloses a process step whereby a cementitious composition is pumped or dropped through a conduit. Therefore, it is respectfully submitted that claim 1, as presently amended, is not taught or suggested by the references.

Claim 6 has been amended to clarify that the aqueous solution is formed by adding a single admixture to water. No new matter has been added. None of Matsumoto, Grier or Jonnes, nor any combination thereof, teaches or suggests forming the aqueous solution by adding the solid components as a single admixture to water. It is respectfully submitted that claim 6, as presently amended, is not taught or suggested by the references.

Claim 19, which recites a method according to claim 6, wherein the single admixture is provided in an easily tearable waterproof container or a water soluble container for adding to the water, finds support at page 3, lines 20-25 and page 4, lines 17-18 of the present specification. None of the references disclose providing a discrete amount of a single admixture solid composition in a container to be added to water. It is therefore respectfully submitted that claim 19 is not taught or suggested by the references.

Claims 3 and 11-13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto, in view of Grier and Jonnes, and further in view of JP 60-001291 to Kuwamoto, et al. ("Kuwamoto").

The discussion of the deficiency in the combination of Matsumoto, Grier and Jonnes as set forth above is incorporated herein by reference. Including Kuwamoto with this combination does nothing to rectify the deficiency, as Kuwamoto discloses an aqueous-based metalworking fluid (Abstract). Kuwamoto discloses a lubricating oil composition, consisting of a specified

lubricating component and a dispersant, which controls behavior of scum formed in metal rolling processes and stabilized rolling operations, reduces smearing around a rolling mill and produced steel with minimized surface defects.

Kuwamoto does not suggest the possibility of other than an aqueous based metalworking fluid. Thus, each reference, or any combination of the references, merely discloses an aqueous based metalworking fluid. A person of skill in the art would not look to these references, or any combination of them, in order to formulate a lubricating composition for conduits used in transporting cementitious compositions. Metalworking fluids are used in metal-on-metal applications to protect the tools used, and to provide a more uniform finished metal surface. A lubricating composition used for cementitious composition transport through metal conduits needs to provide lubrication between the metal and the aggregate in cementitious compositions. For this reason, a person of skill in the art would not look to a metalworking fluid to solve the problem of providing lubrication to a cementitious composition transport conduit, because there would be no motivation and little likelihood of success, since the applications are so different. Therefore, for the reasons described above, claims 3 and 11-13 cannot be suggested by the prior art.

Applicant submits that, since claim 2 is not suggested by the combination of Matsumoto, Grier and Jonnes, for the above reasons, claims 3 and 11-13, which depend, either directly or indirectly, from claim 2, are also not suggested. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03 at page 2100-142.)

Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 3 and 11-13.


In view of the remarks set forth above, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejections of claims 1-18, and the issuance of a formal Notice of Allowance with respect to claims 1-19.

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Should the Examiner have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,



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